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EDELL, SHAPIRO, FINNAN & LYTLE, LLC 1901 RESEARCH BOULEVARD SUITE 400 ROCKVILLE, MD 20850			PHAM, HUNG Q	
		ART UNIT	PAPER NUMBER	
		2162		

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	09/489,730	HARTMAN ET AL.	

Examiner	Art Unit	
HUNG Q PHAM	2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 09 August 2004.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-45 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-45 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____ .

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 08/09/2004 have been fully considered but they are not persuasive.

(a) As argued by applicant at pages 4 and 5:

This rejection is respectfully traversed. Initially, independent claims 1, 16 and 31 recite the features of an identifier file object containing a list of content entity identifiers, wherein the arrangement of the content entity identifiers within the list corresponds to a content object or work hierarchical structure including at least one hierarchical tier and at least one subordinate tier. Independent claims 8, 23 and 38 recite the features of an identifier file object containing an outline of containers and content entity identifiers corresponding to a hierarchical structure of the content object or work, wherein each container represents a hierarchical structure tier and includes at least one content entity identifier forming a subordinate hierarchical tier. Independent claims 1, 8, 16, 23, 31 and 38 further recite the features of: a plurality of content file objects, each containing a content entity identified by one of the content entity identifiers, wherein the content entity identifiers each include identification information identifying the content file object containing the content entity associated with that identifier; and the presence and position of the content entity identifiers (and containers) being modifiable by a user to alter content and arrangement or structure of the content object or work without manipulating the content entities identified by the content entity identifiers.

The McGraw-Hill publication does not disclose, teach or suggest these features.

The Examiner takes the position that the title and/or chapter displayed for a selected portion are the content entity identifiers arranged in a hierarchical fashion. However, these just indicate the origin of the selected portions (e.g., the chapter and book from which the portion is selected) and do not provide a hierarchical arrangement for the new book. In fact, the selected portions themselves define the content of the new book and are arranged as a list. There is no disclosure of the list including a hierarchical structure including subordinate tiers as recited in the claims. In other words, a user can arrange the selected portion order, but there is no disclosure of the portions being arranged into hierarchical tiers.

Examiner respectfully traverses because of the following reasons:

As claimed in claims 1, 16 and 31, *the arrangement of the content entity identifiers within the list corresponds to a content object hierarchical structure*, and in 8, 23 and 38, *an outline of containers and content entity identifiers defining the content and corresponding to a hierarchical structure of the content object, even if the selected portions themselves define the content of the new book and are arranged as a list*, the McGraw-Hill list still meets the requirement of claims 1, 8, 16, 23 and 31, because the requirement of hierarchy is for the content object, and not for the *list* or the *outline of containers*, and the arrangement of the list as illustrated at page 19 of McGraw-Hill corresponds to a book's hierarchical structure in nature, for example, a book with a plurality of chapters, and each chapter has a plurality of sections. In addition, the book is provided in Adobe Acrobat PDF format (McGraw-Hill, page 18), and by using PDF format, a book or *content object* is in hierarchical fashion, because hierarchy is a built-in feature of a PDF file as illustrated at FIG. 2 of Rowe reference.

(b) As argued by applicant at pages 6 and 7:

In addition, the McGraw-Hill publication is silent with respect to the manner in which the selected portions are arranged and handled by the system to form the book and, therefore, does not disclose, teach or suggest the features recited in independent claims 1, 8, 16, 23, 31 and 38 of: a plurality of content file objects, each containing a content entity identified by one of the content entity identifiers, wherein the content entity identifiers each include identification information identifying the content file object containing the content entity

associated with that identifier; and the presence and position of the content entity identifiers (and containers) being modifiable by a user to alter content and arrangement or structure of the content object or work without manipulating the content entities identified by the content entity identifiers.

The Rowe et al. patent does not compensate for the deficiencies of the McGraw-Hill publication. Rather, the Rowe et al. patent discloses optimizing a document file for efficient download and display...

Examiner respectfully traverses because the selected portions as illustrated at page 19 are arranged and handled by the system to form a book in PDF format as disclosed at page 18, and as illustrated at page 19, a user could reorder the content if necessary by clicking the arrow buttons that correspond to the sections without manipulating the text inside of a section name for example. In different words, the technique of reordering performs the claimed *the presence and position of content entity identifiers within said list are modifiable by the user to alter content and arrangement of the content object without manipulating the content entities identified by said content entity identifiers*. At page 19, each section identified by a name as *content entity identifier* contains a number of pages that correspond to that section name, for example: Reading 2: The Mischief of Faction-James Madison has 4 pages. As seen, each page is a *content file object* that contains the content of that page as *content entity*, and the name or *content entity identifier identifies each page as content file object*. In short, the technique as discussed performs the claimed *a plurality of content file objects, each containing a content entity identified by one of the content entity identifiers*. The missing in the McGraw-Hill is the claimed *the content entity identifiers each include identification*

information identifying the content file object containing the content entity associated with that identifier, and this missing feature could be compensated by the teaching of Rowe. As disclosed by Rowe, object types used in a typical PDF file include page objects, page contents objects including text, words and graphical objects (Rowe, Col. 7, Lines 30-40). As shown in FIG. 2a, view 45 is a table of contents or bookmark view (Rowe, Col. 7, Lines 65-66) that allows a user to select and display a particular portion of the document that the user has specifically marked and labeled with text, graphics. For example, different chapter headings can be displayed as labels in bookmark so that when the user selects a chapter, the first page of that chapter is displayed in view window 39 (Rowe, Col. 8, Lines 6-13). Rowe further discloses an object typically includes an object ID to identify the object within the document (Rowe, Col. 12, Lines 52-55). Thus, object ID as *identification information* is a must for a section or chapter represented by their names or *identifier* to *identify* the pages within a section or a chapter, wherein the page is *content file object containing the content entity associated with that identifier*.

(c) As argued by applicant at page 7:

Thus, the internal list is in the form of a listing of identifications and does not include a hierarchical structure including at least one subordinate tier as recited in the claims. Further, the document components are stored in a single file, as opposed to a plurality of file objects each containing a content entity as recited in the claims. Moreover, the internal list of object identifications is generated by the optimization process, where the identifications in

the list are not modifiable by a user to alter the content and structure of the document as recited in the claims.

... There is no disclosure, teaching or suggestion that the document is modifiable, or for that matter, includes content entity identifiers whose positions are modifiable to alter content and structure of the document as recited in the claims.

Examiner respectfully traverses because the internal list does not need to include a hierarchical structure as discussed above, and as illustrated at page 19, each section identified by a name as *content entity identifier* contains a number of pages as *a plurality of content file objects* that contains the content of that page as *content entity*, and the technique of reordering the content if necessary by clicking the arrow buttons performs the claimed *the presence and position of content entity identifiers within said list are modifiable by the user to alter content and arrangement of the content object without manipulating the content entities identified by said content entity identifiers.*

(d) Claims 2-7, 9-15, 17-22, 24-30, 32-37 and 39-45 depend either directly or indirectly from independent claims 1, 8, 16, 23, 31 or 38 are rejected with the reasons as discussed above.

(d) In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to

do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the book is formed in PDF format (McGraw-Hill, page 18), and Rowe technique is to download the PDF for viewing. Thus, the missing of object ID as identification information in McGraw-Hill technique could be compensated by Rowe in order to view the book after downloading.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. **Claims 1-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over The McGraw-Hill Companies (McGraw-Hill) [Build a Book Online, <http://web.archive.org/web/19980513002459/http://mhhe.com/primis/> and <http://www.mhhe.com/primis/catalog/pcatalog/primisweb.ppt>] in view of Rowe et al. [USP 6,073,148].**

Regarding to claims 1, 16 and 31, McGraw-Hill teaches a structure for storing a customized e-book online as *a content object capable of being produced by a processing system and having a plurality of content entities*. As shown in page 10 as an example, a user could select a plurality of predefined sections under a chapter of a selected book to compile into a complimentary custom book in PDF format, and the arrangement of the list as illustrated at page 19 corresponds to a book's hierarchical structure in nature, for

example, a book as *at least one hierarchical tier* and the chapter as *at least one subordinate tier*, or a chapter as *at least one hierarchical tier* and the section of that chapter as *at least one subordinate tier*. In different words, page 19 is *an identifier file object containing a list* of selected section and chapter names as *content entity identifiers defining the content of the content object, wherein the arrangement of the content entity identifiers within the list corresponds to a content object hierarchical structure including a chapter as at least one hierarchical tier and the section of that chapter as at least one subordinate tier, wherein the content entity identifiers are determined by the processing system and placed in the list in response to a user selection of content entities for the content object.*

Returning to page 19, a user could reorder the content if necessary by clicking the arrow buttons that correspond to the sections. Thus, *the presence and position of content entity identifiers within said list are modifiable by the user to alter content and arrangement of the content object without manipulating the content entities identified by said content entity identifiers.* At page 19, each section identified by a name as *content entity identifier* contains a number of pages that correspond to that section name, for example: Reading 2: The Mischief of Faction-James Madison has 4 pages. As seen, each page is a *content file object* that contains the content of that page as *content entity*, and the name or *content entity identifier identifies* each page as *content file object*. In short, the technique as discussed performs the claimed *a plurality of content file objects, each containing a content entity identified by one of the content entity identifiers.* The missing in the McGraw-Hill is the claimed *the content entity identifiers each include identification information identifying the content file object containing the content entity associated with*

that identifier. Rowe teaches an apparatus for organizing a PDF file. As disclosed by Rowe, object types used in a typical PDF file include page objects, page contents objects including text, words and graphical objects (Rowe, Col. 7, Lines 30-40). As shown in FIG. 2a, view 45 is a table of contents or bookmark view (Rowe, Col. 7, Lines 65-66) that allows a user to select and display a particular portion of the document that the user has specifically marked and labeled with text, graphics. For example, different chapter headings can be displayed as labels in bookmark so that when the user selects a chapter, the first page of that chapter is displayed in view window 39 (Rowe, Col. 8, Lines 6-13). Rowe further discloses an object typically includes an object ID to identify the object within the document (Rowe, Col. 12, Lines 52-55). Thus, object ID as *identification information* is a must for a section or chapter represented by their names or *identifier* to *identify* the pages within a section or a chapter, wherein the page is *content file object containing the content entity associated with that identifier*. It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the McGraw-Hill technique by including object ID in each chapter or section in order to identify the pages that belong the that chapter or section.

Regarding to claims 8, 23 and 38, McGraw-Hill teaches a structure for storing a customized e-book online as *a content object capable of being produced by a processing system and having a plurality of content entities*. As shown in page 10 as an example, a user could select a plurality of predefined sections under a chapter of a selected book to compile into a complimentary custom book in PDF format, and the arrangement of the

list as illustrated at page 19 corresponds to a book's hierarchical structure in nature, for example, a book as *at least one hierarchical tier* and the chapter as *at least one subordinate tier*, or a chapter as *at least one hierarchical tier* and the section of that chapter as *at least one subordinate tier*. In different words, page 19 is *an identifier file object containing an outline of selected chapters as containers and selected sections as content entity identifiers defining the content and corresponding to a hierarchical structure of the content object, wherein each chapter as container represents a hierarchical structure tier and includes at least one section name as content entity identifier forming a subordinate hierarchical tier, and wherein the content entity identifier are determined by the processing system and placed in the outline in response to user selection of content entities for the content object*. Returning to page 19, a user could reorder the content if necessary by clicking the arrow buttons that correspond to the sections. Thus, *the presence and position of containers and individual content entity identifiers within said outline are modifiable by the user to alter content and structure of the content object without manipulating the content entities identified by said content entity identifiers*. At page 19, each section identified by a name as *content entity identifier* contains a number of pages that correspond to that section name, for example: Reading 2: The Mischief of Faction-James Madison has 4 pages. As seen, each page is a *content file object* that contains the content of that page as *content entity*, and the name or *content entity identifier contained in said outline identifies each page as content file object*. In short, the technique as discussed performs the claimed *a plurality of content file objects, each containing a content entity identified by one of the content entity identifiers contained in said outline*. The missing in the McGraw-

Hill is the claimed *the content entity identifiers each include identification information identifying the content file object containing the content entity associated with that identifier.*

Rowe teaches an apparatus for organizing a PDF file. As disclosed by Rowe, object types used in a typical PDF file include page objects, page contents objects including text, words and graphical objects (Rowe, Col. 7, Lines 30-40). As shown in FIG. 2a, view 45 is a table of contents or bookmark view (Rowe, Col. 7, Lines 65-66) that allows a user to select and display a particular portion of the document that the user has specifically marked and labeled with text, graphics. For example, different chapter headings can be displayed as labels in bookmark so that when the user selects a chapter, the first page of that chapter is displayed in view window 39 (Rowe, Col. 8, Lines 6-13). Rowe further discloses an object typically includes an object ID to identify the object within the document (Rowe, Col. 12, Lines 52-55). Thus, object ID as *identification information* is a must for a section represented by their names or *identifier* to *identify* the pages within a section, wherein the page is *content file object containing the content entity associated with that identifier*. It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the McGraw-Hill technique by including object ID in each chapter or section in order to identify the pages that belong the that chapter or section.

Regarding to claims 2, 9, 32 and 39, McGraw-Hill and Rowe teaches all the claimed subject matters as discussed in claims 1, 8, 31 and 38, Rowe further discloses

an attribute file object containing at least one attribute pertaining to the content object (Rowe, Col. 9, Lines 14-44).

Regarding to claims 3, 10, 33 and 40, McGraw-Hill and Rowe teaches all the claimed subject matters as discussed in claims 1, 8, 31 and 38, Rowe further discloses *at least one attribute is extracted from the content object* (Rowe, Col. 9, Lines 14-44).

Regarding to claims 4, 11, 34 and 41, McGraw-Hill and Rowe teaches all the claimed subject matters as discussed in claims 1, 8, 31 and 38, Rowe further discloses *ones of the content entities further comprise components associated with the content object, and said file structure further comprises one or more associated component file objects* (Rowe, Col. 9, Lines 14-44).

Regarding to claims 5, 12, 35 and 42, McGraw-Hill and Rowe teaches all the claimed subject matters as discussed in claims 1, 8, 31 and 38, McGraw-Hill further discloses *the content object is one of a book, a collection of images, an album, and a video* (McGraw-Hill, page 1).

Regarding to claims 6, 14, 36 and 44, McGraw-Hill and Rowe teaches all the claimed subject matters as discussed in claims 1, 8, 31 and 38, McGraw-Hill further discloses *the content object is a book and ones of the content entities are one of volumes, chapters and sections* (pages 1 and 19).

Regarding to claims 7 and 15, McGraw-Hill and Rowe teaches all the claimed subject matters as discussed in claims 4 and 11, Rowe further discloses *at least one of the associated components comprises an image* (Rowe, Col. 7, Lines 30-35).

Regarding to claims 13, 28 and 43, McGraw-Hill and Rowe teaches all the claimed subject matters as discussed in claims 8, 23 and 38, McGraw-Hill further discloses *the content object is a book and the containers are one or more of a book, a volume, and a chapter* (pages 1 and 19).

Regarding to claim 17, McGraw-Hill and Rowe teaches all the claimed subject matters as discussed in claim 16, Rowe further discloses the step of *storing at least one attribute pertaining to the work in an attribute file object* (Rowe, Col. 9, Lines 14-44).

Regarding to claim 18, McGraw-Hill and Rowe teaches all the claimed subject matters as discussed in claim 16, Rowe further discloses *at least one attribute is extracted from the work* (Rowe, Col. 9, Lines 14-44).

Regarding to claim 19, McGraw-Hill and Rowe teaches all the claimed subject matters as discussed in claim 16, Rowe further discloses *ones of the content entities further comprise components associated with the work, and further comprising the step of*

storing the components in one or more associated component file objects (Rowe, Col. 9, Lines 14-44).

Regarding to claim 20, McGraw-Hill and Rowe teaches all the claimed subject matters as discussed in claim 16, McGraw-Hill further discloses *the work is one of a book, a collection of images, an album, and a video* (pages 1 and 19).

Regarding to claims 21 and 29, McGraw-Hill and Rowe teaches all the claimed subject matters as discussed in claims 16 and 23, McGraw-Hill further discloses *the work is a book and ones of the content entities are one of volumes, chapters and sections* (pages 1 and 19).

Regarding to claims 22 and 45, McGraw-Hill and Rowe teaches all the claimed subject matters as discussed in claims 19 and 41, Rowe further discloses *at least one of the associated components comprises one of an image, a video segment and an audio segment* (Rowe, Col. 7, Lines 30-35).

Regarding to claim 24, McGraw-Hill and Rowe teaches all the claimed subject matters as discussed in claim 23, Rowe further discloses *storing at least one attribute pertaining to the work within an attribute file object* (Rowe, Col. 9, Lines 14-44).

Regarding to claim 25, McGraw-Hill and Rowe teaches all the claimed subject matters as discussed in claim 23, Rowe further discloses *at least one attribute is extracted from the work* (Rowe, Col. 9, Lines 14-44).

Regarding to claim 26, McGraw-Hill and Rowe teaches all the claimed subject matters as discussed in claim 23, Rowe further discloses *ones of the content entities further comprise components associated with the work, and storing the components in one or more associated component file objects* (Rowe, Col. 9, Lines 14-44).

Regarding to claim 27, McGraw-Hill and Rowe teaches all the claimed subject matters as discussed in claim 23, McGraw-Hill further discloses *the work is one of a book, a collection of images, an album, and a video* (pages 1 and 19).

Regarding to claims 30 and 37, McGraw-Hill and Rowe teaches all the claimed subject matters as discussed in claims 26 and 34, Rowe further discloses *at least one of the associated components comprises one of an image, a video segment and an audio segment* (Rowe, Col. 7, Lines 30-35).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUNG Q PHAM whose telephone number is 571-272-4040. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN E BREENE can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner Hung Pham
December 6, 2004

Shahid Alam
SHAHID ALAM
PRIMARY EXAMINER